

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:
MURAYAMA, Yuicgu, et al.
Serial No: 09/890,799
National Phase of PCT/US1999/02445
Filed: 3 August 2001
For: Thermo-Reversible Polymer for
Intraluminal Implant

Art Unit: 1615
Examiner: AZPURU, Carlos A.

Renewed Petition Under 37 CFR 1.181 Including Petition to Reinstate Notice of Acceptance

Commissioner for Patents
Mail Stop PCT
PCT Legal Affairs (Facsimile 571 273-0459)
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This petition is in response to a Decision (dated 12 Sept. 2007) dismissing without prejudice of our Petition of 07 June 2007. That Decision also vacated the 12 April 2002 Notice of Acceptance in the above-captioned case.

Applicants thank the Legal Examiner for correcting the inventorship in this case—something that Applicants have been trying to achieve for several years. However, Applicants respectfully request that the Notice of Acceptance be reinstated. In the discussion to the Decision the Legal Examiner indicates that the Declaration is defective because it does not contain signatures of all the inventors.

Applicants respectfully submit that signatures of all three inventors were submitted to the Office. Applicants point out that the Postcard from the Response for Notice of Missing Requirements (submitted 4 Dec. 2001) has the notation “(2)” on its face next to the “Declaration” section. This somewhat cryptic notation was an indication that the Declaration is in two parts. Between the time that the original PCT was filed and the U.S. National Phase was entered, one of the inventors returned to Japan. To avoid the complexity of sending signed documents to and from Japan the

Declaration was prepared in duplicate. The two U.S. resident inventors signed one copy, and Yuichi Mori, the Japan resident inventor, signed the other. Both sheets of the Declaration were submitted to the Office on 4 December 2002. Applicants respectfully submit that the submitted documents satisfy the requirements of 37 CFR 1.1497(a)-(b). The Decision indicated that only one inventor, namely Yuichi Mori, had signed. The undersigned attorney concludes that one sheet of the Declaration has become misplaced in the file.

However, the undersigned attorney is unable to confirm this assumption because reference to the Image File Wrapper on Private PAIR does not show any entry for 30 Jan 2002, the date that the return postcard indicates the Declaration was received by the Office. Instead the only entry in 2002 prior to the Notice of Acceptance (12 April 2002) is a "Miscellaneous Incoming Letter" (47 pages) dated 02 Jan 2002. An examination of that Letter reveals that it contains a copy of the entire application as filed with a two page Declaration appended to its end. The two page Declaration is from the firm of Baker & Botts and is related to PCT/EP00/01524. That Declaration is signed by Inventor Wolfgang Werr and references Application Serial No. 09/890,799 so presumably this entire confusion was started by Baker & Botts mistyping the serial number of the Nation Phase application of PCT/EP00/01524. However, the undersigned attorney is now unsure of where Applicants' Reply to the Notification of Missing Requirements is to be found within the file. Apparently, the Legal Examiner had access to an incomplete copy although no part of the Reply appears to be part of the Image File Wrapper available in Private PAIR.

The Petition of 7 June 2007 indicates that both pages of the Declaration were attached, but it now appears that through error only the return postcard was attached. Therefore, Applicants are now attaching a true copy of the 4 December 2001 Reply to Notification of Missing Requirements. Since it is apparent from that document that all requirements were timely met, Applicants respectfully request that a Notice of Acceptance with the correct inventors designated issue in this case. Because the inventorship has already been corrected, all requirements of the In re Quayle Notice have now been met and the case should proceed to issue.

If for any reason the PCT Legal Division requires additional information, please call the undersigned attorney at the Los Angeles telephone number (310) 229-9928. You are hereby authorized to charge any fees due and refund any surplus fees to our Deposit Account No. 22-0261. Please reference matter number 58056-244181.

Respectfully submitted,

VENABLE LLP

Date: 26-Sept-2007

By: /Stefan J. Kirchanski/
Stefan J. Kirchanski
Registration No. 36,568
Attorney for Applicant(s)

2049 Century Park East., 21st Floor
Los Angeles, CA 90067
Telephone: (310) 229-9900
Facsimile: (310) 229-9901
Email: SJKirchanski@venable.com

Filed Herewith (6 sheets total):

Response to Notification of Missing Requirements, including:

- a. Copy of Notification of Missing Requirements
- b. Copy of Postcards
- c. Response Transmission
- d. Extension of Time Request
- e. Declaration with Murayama and Vinuela signatures
- f. Declaration with Mori signature



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents, Box PCT
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

U.S. APPLICATION NO. 09/890799

FIRST NAMED APPLICANT

Y ATTY. DOCKET NO. 3054, 02140

09/890799

5071

INTERNATIONAL APPLICATION NO. PCT/US99/02445

STEFAN J KIRCHANSKI
CROSBY HEAFEY ROACH & MAY
1901 AVENUE OF THE STARS SUITE 700
LOS ANGELES CA 90067

I.A. FILING DATE 02/05/99 PRIORITY DATE 00/00/00

09/04/01

DATE MAILED:

NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)

1. The following items have been submitted by the applicant or the IB to the United States Patent and Trademark Office as ☐ a Designated Office (37 CFR 1.494) ☒ an Elected Office (37 CFR 1.495):
- ☒ U.S. Basic National Fee.
 - ☒ Copy of the international application.
 - ☐ Oath or Declaration of inventors(s).
 - ☐ Copy of Article 19 amendments.
 - ☐ Priority Document.
 - ☒ The International Preliminary Examination Report in English and its Annexes, if any.
 - ☐ Translation of Annexes to the International Preliminary Examination Report into English.
 - ☒ Indication of Small Entity Status.
 - ☐ Translation of the international application into English.
 - ☐ Translation of Article 19 amendments into English.
 - ☐ Other:
2. ☒ Applicant has requested early processing under 35 U.S.C. 371(f) but has not filed the following indicated items and/or the indicated items in paragraph 3 below. The Basic National Fee and the copy of the international application must be filed prior to 20 or 30 months from the priority date to avoid abandonment.
- ☐ U.S. Basic National Fee.
 - ☐ Copy of the international application.
3. The following items **MUST** be furnished within the period set forth below in order to complete the requirements for acceptance under 35 U.S.C. 371:
- ☐ a. Translation of the application into English. A processing fee will be required if submitted later than the appropriate 20 or 30 months from the priority date.
 - ☐ The current translation is defective for the reasons indicated on the attached Notice of Defective Translation.
 - ☐ b. Processing fee for providing the translation of the application and/or the Annexes later than the appropriate 20 or 30 months from the priority date (37 CFR 1.492(f)).
 - ☒ c. Oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), properly identifying the application (preferably by the International application number and international filing date). A surcharge will be required if submitted later than the appropriate 20 or 30 months from the priority date.
 - ☐ The current oath or declaration does not comply with 37 CFR 1.497(a) and (b) for the reasons indicated on the attached PCT/DO/EO/917.
 - ☐ d. Surcharge for providing the oath or declaration later than the appropriate 20 or 30 months from the priority date (37 CFR 1.492(e)).
4. Additional claim fees of \$ _____ as a ☐ large entity ☐ small entity, including any required multiple dependent claim fee, are required. Applicant must submit the additional claim fees or cancel the additional claims for which fees are due (37 CFR 1.492(g)). See attached PTO-875.
5. ☐ Applicant has not submitted the required sequence listing pursuant to 37 CFR 1.821-1.825. See attached PCT/DO/EO/920.

ALL OF THE ITEMS SET FORTH IN 3(a)-3(d), 4 AND 5 ABOVE MUST BE SUBMITTED WITHIN TWO (2) MONTHS FROM THE DATE OF THIS NOTICE OR BY 22 OR 32 MONTHS (where 37 CFR 1.495 applies) FROM THE PRIORITY DATE FOR THE APPLICATION, WHICHEVER IS LATER. FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.

The time period set above may be extended by filing a petition and fee for extension of time under the provisions of 37 CFR 1.136(a).

6. If box 3a or 3c is checked, a translation of the Annexes **MUST** be submitted no later than the time period set above or the Annexes will be cancelled. A processing fee will be required if submitted later than 20 or 30 months from the priority date.
7. ☐ The Article 19 amendments are cancelled since a translation was not provided by the appropriate 20 (37 CFR 1.494(d)) or 30 (37 CFR 1.495(d)) months from the priority date.

Applicant is reminded that any communication to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above. (37 CFR 1.5)

A copy of this notice MUST be returned with this response.

Enclosed: ☐ PCT/DO/EO/917 ☐ Notice of Defective Translation
☐ PTO-875 ☐ PCT/DO/EO/920

DOCKETED

SEP 19 2001

Due: 11-4-

R14

FILE

S.N. 09/890,799 File No. 13054.02140 Mailed 12/4/2001 By: SJK/kh
Title: THERMO-REVERSIBLE POLYMER FOR INTRALUMENAL IMPLANT
Client Name: Reports of the University of California
The following, due 12/4/2001 in the U.S. Patent & Trademark Office, was received in the Patent & Trademark Office on the date stamped hereon:

☐ Patent Appln: ☐ Prov'l ☐ Utility ☐ Div. ☐ Cont. ☐ CIP ☐ Design

Parent/Prior Appln. No. if applicable: _____

_____ Pages Spec. _____ Page Abstract _____ Claims(s)

☒ Declaration ☒ Power of Attorney (☐ Copy, from parent) (2)

☒ Assignment and Recordation Cover Sheet (☐ Copy) (2)

☐ Check No. _____ for \$ _____

☐ Check No. _____ for \$ _____

☐ Assertion of Small Business Entity Status Under 37 CFR 1.27

☐ RCE/☐ CPA ☒ ~~_____~~ FEE TO BE PAID BY DEPOSIT ACCOUNT

☐ Certificate of Express Mail, Label No. _____

☐ Amendment/Response ☐ Restriction Req. ☐ After Final ☐ After Allowance

☒ Request for Extension of Time, 1 month(s)

☒ EXTENSION FEE TO BE PAID BY DEPOSIT ACCOUNT

☐ Revocation and Power of Attorney ☐ Statement Under 37 CFR 3.73(b)

☐ Change of Correspondence Address ☐ Associate Power of Attorney ☐ Associate With Customer Number

☒ Petition for

☒ Copy of Notification of Missing Requirements Under 35 USC 371

☐ Preliminary Amendment

☐ Letter of Transmittal

☐ Drawings, _____ Sheets

☐ Formal ☐ Informal

☐ Priority Document

Country _____ Doc. No. _____
☐ IDS: _____ Reference(s)

☐ Enclosed ☐ Listed only

☐ Certified Copy, _____ Docs

☒ Response to Missing Parts

☐ Notice of Appeal ☐ Brief

☐ Issue Fee Transmittal

☐ Advance soft copy order

S.N. 09/890,799 File No. 13054.02140 Mailed 12/4/2001 By: SJK/kh
Title: THERMO-REVERSIBLE POLYMER FOR INTRALUMENAL IMPLANT
Client Name: Reports of the University of California
The following, due 12/4/2001 in the U.S. Patent & Trademark Office, was received in the Patent & Trademark Office on the date stamped hereon:

☐ Patent Appln: ☐ Prov'l ☐ Utility ☐ Div. ☐ Cont. ☐ CIP ☐ Design

Parent/Prior Appln. No. if applicable: _____

_____ Pages Spec. _____ Page Abstract _____ Claims(s)

☒ Declaration ☒ Power of Attorney (☐ Copy, from parent) (2)

☒ Assignment and Recordation Cover Sheet (☐ Copy) (2)

☐ Check No. _____ for \$ _____

☐ Check No. _____ for \$ _____

☐ Assertion of Small Business Entity Status Under 37 CFR 1.27

☐ RCE/☐ CPA ☒ ~~_____~~ FEE TO BE PAID BY DEPOSIT ACCOUNT

☐ Certificate of Express Mail, Label No. _____

☐ Amendment/Response ☐ Restriction Req. ☐ After Final ☐ After Allowance

☒ Request for Extension of Time, 1 month(s)

☒ EXTENSION FEE TO BE PAID BY DEPOSIT ACCOUNT

☐ Revocation and Power of Attorney ☐ Statement Under 37 CFR 3.73(b)

☐ Change of Correspondence Address ☐ Associate Power of Attorney ☐ Associate With Customer Number

☒ Petition for

☒ Copy of Notification of Missing Requirements Under 35 USC 371

☐ Preliminary Amendment

☐ Letter of Transmittal

☐ Drawings, _____ Sheets

☐ Formal ☐ Informal

☐ Priority Document

Country _____ Doc. No. _____
☐ IDS: _____ Reference(s)

☐ Enclosed ☐ Listed only

☐ Certified Copy, _____ Docs

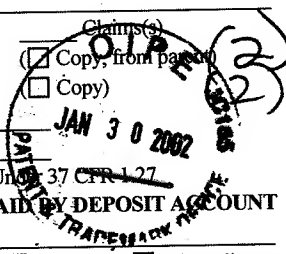
☒ Response to Missing Parts

☐ Notice of Appeal ☐ Brief

☐ Issue Fee Transmittal

☐ Advance soft copy order

1010 Rec'd PCT/PTO 3.0 JAN 2002



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Yuichi MURAYAMA et al.

Serial No: 09/890,799

Int'l Appln. No. PCT/US99/02445

For: THERMO-REVERSIBLE POLYMER FOR
INTRALUMENAL IMPLANT

Int'l Filing Date: 02/05/99

Priority Date: 00/00/00

**RESPONSE TO NOTIFICATION OF MISSING
REQUIREMENTS UNDER 35 U.S.C. 371**

Box MISSING PARTS
Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

In response to the "Notification of Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US)," dated September 4, 2001, response to which is extended from November 4, 2001 to December 4, 2001 by the accompanying Petition, enclosed are the following:

- ☒ A copy of the "Notification of Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US)."
- ☒ A "Declaration and Power of Attorney" executed by the inventor(s) in two counterparts.
- ☒ A "Petition for Extension of Time" for one month(s).
Fee: \$ 55 ☐ Check enclosed
- ☐ Filing Fee: \$ ☐ Check enclosed
- ☒ Surcharge for late filing of Declaration.
Fee: \$ 65 ☐ Check enclosed
- ☒ Two executed Assignments with Recordation Cover Sheets.
Recordation Fee: \$ 80 ☐ Check enclosed

The Commissioner is authorized to charge any underpayment to Deposit Account No. 50-1796, referencing docket number 13054.02140. A copy of this letter is enclosed.

Respectfully submitted,

CROSBY, HEAFEY, ROACH & MAY

Date: December 4, 2001

By: Stefan J. Kirchanski
Stefan J. Kirchanski
Registration No. 36,568
Attorney for Applicant(s)

1901 Avenue of the Stars, Suite 700
Los Angeles, CA 90067
Phone: (310) 734-5200
Fax: (310) 734-5299

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:
Commissioner for Patents
Washington D.C. 20231, on
December 4, 2001
Date of Deposit
Kathy Hinchley
Name
[Signature]
Signature
12/4/01
Date

PATENT
13054.02140

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:
Yuichi MURAYAMA et al.
Serial No: 09/890,799
Int'l Appln. No. PCT/US99/02445
For: THERMO-REVERSIBLE POLYMER FOR
INTRALUMENAL IMPLANT

Int'l Filing Date: 02/05/99

Priority Date: 00/00/00

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

Commissioner for Patents
Washington D.C. 20231, on

December 4, 2001

Date of Deposit

Kathy Hinkley

Name

[Signature]

Signature

12/4/01

Date

PETITION FOR EXTENSION OF TIME

Box MISSING PARTS
Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

In accordance with 37 C.F.R. 1.136, Applicant respectfully petitions the Commissioner for a one-month extension of time extending to December 4, 2001, the period for response to the Notification of Missing Requirements Under 35 U.S.C. 371 dated September 4, 2001. Please charge the fee of \$55 for this extension to Deposit Account No. 50-1796, referencing docket number 13054.02140. The responsive paper(s) are attached.

Please charge any insufficiency or credit any overpayment to Deposit Account No. 50-1796, referencing docket number 13054.02140. A copy of this petition is enclosed.

Respectfully submitted,

CROSBY, HEAFEY, ROACH & MAY

Date: December 4, 2001

By: Stefan J. Kirchanski

Stefan J. Kirchanski

Registration No. 36,568

Attorney for Applicant(s)

1901 Avenue of the Stars, Suite 700
Los Angeles, CA 90067
Phone: (310) 734-5200
Fax: (310) 734-5299